

REMARKS

Claims 1, 3-4 and 6-20 remain pending in this application. Claims 2 and 5 have been canceled without prejudice or disclaimer. Claims 3, 4 and 6 have been placed in independent form, whereas claim 9 has been amended to add dependencies on claims 3 and 4. An Information Disclosure Statement was filed on July 13, 2004, that has not been considered by the Examiner. We understand that claims 6-8 and claims 9-17 (to the extent they are dependent on claims 6 and 8) are considered allowable.

Applicants acknowledge, with appreciation, the telephone interview conducted with Examiner Pritchett by the undersigned on February 4, 2005. It was decided that filing an RCE with a reply to the final Office action was the most efficient procedure for obtaining consideration of the amended claims and the documents cited in the Information Disclosure Statement filed July 13, 2004. Accordingly, an RCE has been filed with this reply.

Claim 17 has been objected to because claim 17 is allegedly a Markush group and allegedly must have the phrase "a group consisting of." While both claims 17 and 20 recite a group of alternatives similar to a so-called Markush group, there is no requirement to use the language suggested by the Examiner or anything wrong or indefinite about the language in these claims. Accordingly, the Examiner is requested to withdraw this objection.

Claims 1-5 were rejected under 35 U.S.C. § 102(e) as being anticipated by Belleville. According to the Office, Belleville teaches a composition comprising the 4 oxides recited in these claims and also suggests a broad range (from 1 to 99%, preferably 10 to 90% by mass of each oxide) that covers the percentages of the oxide

ingredients that are recited in claims 3 and 4. The teachings of Belleville cannot establish anticipation or even obviousness of the claimed invention simply because the claimed ingredients and the recited percentages of ingredients in general arguably fall within the scope of the broad disclosure of Belleville.

The Office suggests that if any one of the possibilities disclosed by Belleville meet the claim limitations, then the claims “read on” the prior art. While it is not clear what the Office means by the term “read on,” it cannot mean or necessarily justify anticipation or obviousness. Consider, for example, the decision in *In re Baird*, 16 F.3d 380, 382, 29 USPQ2d 1550, 1552 (Fed. Cir. 1994) wherein it was held that the mere fact that a compound may be encompassed by a generic formula does not by itself mean that the compound is even *prima facie* obvious, to say nothing about anticipated. See also MPEP 2144.08. Unlike most of the cases cited by the Examiner, Belleville does not name the claimed species. In fact, there is no species (i.e., specific combination of oxides) or any other preference described in Belleville that uses even one (of a minimum of three) of the claimed oxides. Further, the broad suggestion of using any oxide in an amount of from 1 to 99% does not begin to suggest what might be appropriate for any particular oxide. For this additional reason, Belleville is not a sufficient teaching to anticipate claims 3 and 4. Reconsideration and withdrawal of this rejection is requested.

Claims 9/1 and 10-14/1 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Belleville et al. in view of Rahilly (U.S. Patent No. 4,116,717). The Office recognizes that Belleville et al. lacks reference to sintering of the oxides prior to vaporation, even though this patent acknowledges (column 1) that such process steps

are conventionally employed in preparing layers for optical elements. Belleville et al. seeks to avoid the conventional physical processes of sintering and deposition under vacuum, opting instead for the use of an inorganic polymer that is densified and cross-linked by a heat treatment at a moderate temperature or by exposure to ultra-violet rays (Belleville et al. at column 6, lines 38-43). Rahilly does teach that a conventional antireflecting coating such as tantalum oxide or silicon oxide can be applied following sintering (column 3, lines 23-28). Rahilly et al. does not teach that other oxides can or should be present when forming the antireflecting coating. Rahilly uses a process for deposition of the antireflection film that Belleville et al. seeks to avoid, and there is nothing in Rahilly that would motivate a person skilled in the art to select at least the three oxides recited in claim 1 for such a layer or to predict that such a layer containing these oxides could be successfully deposited using sintering and vacuum vaporization techniques.

The Office has pointed out that both references teach an antireflective coating containing tantalum oxide that would allegedly strongly suggest that the methods used to create the Rahilly antireflective layer would also work for the Belleville et al. antireflective layer. Even assuming that were true for an antireflective coating of tantalum oxide alone, there is nothing in either of these references to suggest that such a procedure would be appropriate or desirable for a coating containing the four oxides recited in claim 1, particularly since the only reference (Belleville et al.) that broadly suggests a combination of oxides teaches away from using a sintering process. There is nothing in this combination of references that would provide the necessary motivation

or predictability of success to establish a *prima facie* case of obviousness of the rejected claims.

The Office has argued that a person of ordinary skill in this art would recognize that the teachings of Belleville and Rahilly could be combined based on the fact that both relate to the formation of layers containing tantalum oxide - an oxide not recited in the instant claims. These bare assertions, absent any basis in the teachings of the prior art, are factually and legally insufficient to provide any motivation to combine these references, particularly since Belleville expressly avoids the very procedure the Office seeks to combine with its teachings. Further, although the Office stated that the Examiner provided the motivation, it is axiomatic that the teaching or suggestion to make the combination of references must be found in the prior art or based on the knowledge of those skilled in the art. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). See also MPEP 2142. The Office has not provided any evidence to support its theory of motivation. Accordingly, this rejection should be withdrawn.

Claims 15-17/1 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Belleville et al. in view of Rahilly and Asai et al. (U.S. Patent No. 5,116,644). In addition to the deficiencies of Belleville et al. and Rahilly discussed above, Asai et al. fails to provide any teaching that would cure these deficiencies or otherwise provide a motivation to select the unique combination of oxides recited in claim 1 to be deposited in the manner recited in claim 9 to meet the limitations of these claims. Accordingly, this rejection should be withdrawn.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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GARRETT & DUNNER, L.L.P.

Dated: February 7, 2005

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Attachments: **Request for Continued Examination (RCE)**
Petition for Extension of Time
Transmittal Letter